

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-23 and 25-31 were pending in the application and were rejected in the Office Action. By way of this amendment, Applicant has: (a) amended the preamble of claim 29 to correct a typographical error; and (b) added new claims 32-37. Accordingly, claims 1-23 and 25-37 are pending for further consideration.

1. Rejections of Claims 1-23 and 25-31

The Office Action rejected: (a) claims 1-19, 21-23, and 25-31 under 35 U.S.C. § 103(a) as allegedly having been obvious when considering U.S. Patent No. 4,810,084 (“Nyui”) in view of U.S. Patent No. 6,305,801 (“Kerns”); and (b) claim 20 under 35 U.S.C. § 103(a) as allegedly having been obvious when considering Nyui in view of Kerns and further in view of U.S. Patent No. 6,271,968 (“Dobrowolski”). For at least the following reasons, Applicant respectfully continues to traverse each of these rejections.

As previously presented, claim 1 (*i.e.*, the claim from which claims 2-23 and 25 depend) recites an optical device that includes, among other possible things (*italic emphasis added*):

- a housing, the housing comprising:
 - a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area;
 - a main objective; and
 - a spectral filter positioned between the light source and the main objective,*
- wherein the spectral filter is adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam.*

Similarly, as previously presented, claim 26 (*i.e.*, the claim from which claims 27-31 depend) recites a surgical microscope that includes, among other possible things (*italic emphasis added*):

- an optical device housing comprising:
 - a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area;
 - a main objective;
 - a spectral filter that is configured to be positioned between the light source and the main objective, wherein the spectral filter is:*
 - (a) adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-*

dimensional cross-sectional area of the illuminating beam; and

(b) configured to be displaced vertically and/or horizontally when positioned between the light source and the main objective; and

a control circuit configured to control the vertical and/or horizontal displacement of the spectral filter.

As hereafter explained, no proper combination of Nyui, Kerns, and/or Dobrowolski teaches or suggests the optical device recited in claim 1 or the surgical microscope recited in claim 26.

Preliminarily, Applicant hereby incorporates each of the arguments previously set forth in the Amendment and Reply filed on April 15, 2005 and the Amendment and Reply filed on March 29, 2006. In addition, as hereafter explained, the combination of Nyui and Kerns (and Dobrowolski) can not be used to reject claims 1 and 26, or any claim dependent thereon under 35 U.S.C. § 103(a), for at least these additional reasons.

In the “Response to Arguments” section of the Office Action, the Office Action asserts:

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Office Action at p. 2 (citations omitted). With respect to this assertion of the law of obviousness, Applicant agrees. With respect to the Office Action’s application of this assertion, however, Applicant respectfully disagrees. An ophthalmologic surgeon, *i.e.*, one of ordinary skill in the art, needs access to an eyeball in order to operate on such an eyeball. Accordingly, such a surgeon would not be motivated to incorporate the teachings of a device (Kerns’ contact lens) that has a purpose of being adhered to an eyeball (such that the device blocks access to the eyeball) into a device (Nyui’s microscope) that is used by the surgeon when operating on an eyeball. Moreover, the functionality of Kerns’ contact lens is dependent on ambient light conditions, which affect the size of the eye’s pupil. *See* Kerns at Abstract. As a result of the inconsistency in the functionality of Kerns’ contact lens, an ophthalmologic surgeon would be further motivated to avoid the teachings of Kerns rather than incorporate them into Nyui’s microscope. In light of the foregoing and contrary to M.P.E.P. § 2143, “the combined teachings of the references would have suggested to” an ophthalmologic surgeon that the references were incompatible and, therefore, that the references’ teachings should not be combined.

For at least the foregoing additional reasons, it is clear that any combination of Nyui, Kerns, and Dobrowolski fails to teach or suggest at least the above-italicized limitations of claims 1 and 26. As a result, the combination of Nyui, Kerns, and Dobrowolski can not be used to reject claims 1 and 26, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claims 2-23 and 25 depend from claim 1 and as claims 27-31 depend from claim 26, each of these dependent claims is also allowable over Nyui, Kerns, and Dobrowolski, without regard to the other patentable limitations recited therein. Accordingly, a withdrawal of the various rejections of claims 1-23 and 25-31 under § 103(a) is both warranted and respectfully requested.

2. New Claims 32-33

A. New Claims 32 and 33

New dependent claims 32 and 33 respectively depend from independent claims 1 and 26. Accordingly, new claims 32 and 33 are allowable for at least the same reasons as claims 1 and 26, even without regard to the other patentable limitations recited therein. However, with respect to claims 32 and 33 it is additionally noted that the beam path from Nyui's light source 6 to the lens 13 is bent by the mirror 11. As a result, Nyui's beam path is not "substantially linear," as required by claims 32 and 33. Accordingly, claims 32 and 33 are also allowable for at least this additional reason.

B. New Claims 34 and 35

New dependent claims 34 and 35 respectively depend from independent claims 1 and 26. Accordingly, new claims 34 and 35 are allowable for at least the same reasons as claims 1 and 26, even without regard to the other patentable limitations recited therein. However, with respect to claims 34 and 35 it is additionally noted that claims 34 and 35 recite at least one viewer that "is configured to receive a return beam that is not co-linear with the illuminating beam." In contrast, the return beam in Nyui from the eye 4 to the photographing system 2 appears to be co-linear with the illuminating beam from the mirror 14 to the lens 13. As a result, Nyui's return beam fails to satisfy the limitations of claims 34 and 35. Accordingly, claims 34 and 35 are also allowable for at least this additional reason.

C. New Claims 36 and 37

New dependent claims 36 and 37 respectively depend from independent claims 1 and 26. Accordingly, new claims 36 and 37 are allowable for at least the same reasons as claims 1 and 26, even without regard to the other patentable limitations recited therein. However, with respect to claims 36 and 37 it is additionally noted that these claims recite that "at least a

portion of a central region of the light emitted by the light source is incident on the main objective." In contrast, Nyui teaches an aperture 10 that appears to block all of the central portion of the illuminating beam from reaching the mirror 11 and subsequently the lens 13. As a result, Nyui's illuminating beam path fails to satisfy the limitations of claims 36 and 37. Accordingly, claims 36 and 37 are also allowable for at least this additional reason.

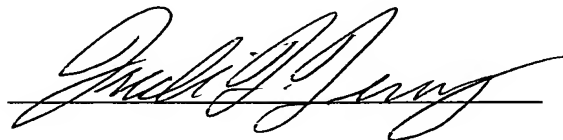
CONCLUSION

For the aforementioned reasons, claims 1-23 and 25-37 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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By



Customer Number: 22428
FOLEY & LARDNER LLP
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007-5143

Glenn Law
Registration No. 34,371

Frederic T. Tenney
Registration No. 47,131

Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Attorneys for Applicant

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